

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 20, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Smith & Vandiver, Corp.

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Serial No. 88477576

Brent Capehart of Capehart Law Firm,
for Smith & Vandiver, Corp.

Diana Zarick, Trademark Examining Attorney, Law Office 126,
Andrew Lawrence, Managing Attorney.

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Before Kuhlke, Dunn, and Allard,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Smith & Vandiver, Corp. (“Applicant”) seeks registration on the Principal Register of the mark CALIHEMP (in standard characters) for “skin and body topical lotions, creams, oils, balms and salves for cosmetic use, all of the foregoing containing hemp oil extract containing hemp ingredients solely derived from hemp with a delta-9

tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis,” all in International Class 3.¹

The Examining Attorney refused registration under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), on the ground that Applicant’s mark, as used in connection with the goods indicated above, is primarily geographically descriptive. After the refusal was made final,² Applicant appealed³ and its appeal brief was forwarded to the Examining Attorney.⁴ The Examining Attorney then filed a motion to remand to address an issue under the Controlled Substances Act (“CSA”), which was unrelated to the issue on appeal.⁵ The request for remand was granted, the appeal was suspended, and jurisdiction was restored to the Examining Attorney.⁶ After the CSA issue was resolved, the appeal of the refusal based on geographic

¹ Application Serial No. 88477576 was filed on June 18, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

² April 4, 2020 Office Action.

Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number, and after this designation are the page references, if applicable. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018).

³ 1 TTABVUE.

⁴ 5 TTABVUE.

⁵ 6 TTABVUE.

⁶ 7 TTABVUE.

descriptiveness was resumed.⁷ The appeal is fully briefed. We affirm the refusal to register.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Specifically, Applicant identified for the first time in its brief certain registered marks that contain the term CALI in support of its argument that the mark is not primarily geographically descriptive.⁸ The Examining Attorney objects on two grounds. First, the Examining Attorney argues that the evidence is untimely because the record should be complete prior to appeal.⁹ Second, the Examining Attorney argues that identifying marks merely by their registration number is insufficient to make them of record, as Applicant is required to submit printouts of the registrations from the USPTO's electronic database showing their current status and title.¹⁰

We sustain the Examining Attorney's objection and do not consider the registrations cited by Applicant. The record should be complete prior to appeal, so Applicant's introduction of this evidence in its brief is untimely. Trademark Rule 2.142(d), 37 CFR § 2.142(d). *See In re tapio GmbH*, 2020 USPQ2d 11387, at *3 (TTAB 2020) (screen shots from applicant's website that were embedded in applicant's brief and other materials that were first filed with applicant's brief not considered).

⁷ 9 TTABVUE.

⁸ Applicant's brief (10 TTABVUE 9).

⁹ Examining Attorney's brief (12 TTABVUE 4-5).

¹⁰ *Id.* (12 TTABVUE 5).

II. Primarily Geographically Descriptive Refusal

Establishing that a term is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), requires a showing that:

- (1) the primary significance of the term in the mark sought to be registered is the name of a place that is generally known to the public;
- (2) the goods originate in the place identified in the mark; and
- (3) the public would make an association between the goods and the place named in the mark by believing that the goods originate in that place.

In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448 (Fed. Cir. 2015).

See also In re Societe Generale Des Eaux Minerales de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014).

A. The First Element – Primary Significance

To support refusing the mark as primarily geographically descriptive, the Examining Attorney made of record a variety of evidence, including evidence that the term CALI is the nickname for the state of California:

- Acronym Finder: “Cali stands for California.”¹¹
- The Online Slang Dictionary: The definition of “Cali” is a “nickname for the state of California.” Also noting, “Some native Californians look down at the use of ‘Cali’ as a nickname for California.”¹²

¹¹ September 4, 2019 Office Action at TSDR 7.

¹² *Id.* at 8.

- Wikipedia: Under the category “Places,” the term “Cali” is defined as “an informal short form of the name of the US state of California.”¹³
- Wiktionary: “Cali” is defined as slang for “[t]he state of California in the United States.”¹⁴
- Urban Dictionary: The second definition of “Cali” is “[a]n annoying name for California.”¹⁵
- Los Angeles Times Op-Ed: “Don’t call us ‘Cali.’ We’re California, thank you.”¹⁶ The opinion piece also states: “I’m declaring a moratorium on ‘Cali,’ and I’d like to retire every other nickname too. Let’s call ourselves California and be done with it.”¹⁷ It concludes: “[N]o ‘Cali’ for California. Such names shrink the lens, narrow the focus, make us less than what we are.”¹⁸
- Business Insider: In the article titled “12 sayings only people from California will understand.” Item 12 on the list is “Whatever you do, definitely don’t say ‘Cali.’” “The only people who *don’t* refer to California as ‘Cali’ are the Golden State natives themselves. You will very, very rarely

¹³ *Id.* at 9.

¹⁴ *Id.* at 10.

¹⁵ *Id.* at 11.

¹⁶ *Id.* at 30-32.

¹⁷ *Id.* at 31.

¹⁸ *Id.* at 32.

hear a Californian call their home state by this name, even though people from everywhere else love to call it that.”¹⁹

Other evidence made of record by the Examining Attorney shows that the term CALI is used by persons in the hemp industry to refer to the state of California and that hemp-based goods commonly originate from there:

- Cali Cannabis Marketplace (calicannabismarketplace.com) promotes itself as “The Best in Cali, from the Coast to the Valley.”²⁰ This website advertises a range of personal care products containing hemp-based ingredients and lists a mailing address in California.²¹
- Cali CBD (shopcalicbd.com) offers personal care products containing hemp-based ingredients.²² In the “About Cali CBD” section, it states: “Cali CBD was founded by three health-conscious friends in Southern California after seeing the benefits of CBD first hand.”²³
- CaliGarden (caligardencbdoil.com) contains a CBD product review that states: “The Cali Garden CBD ingredients contain natural hemp leaves that seem to come straight from a Californian garden! ... While it may not be a ‘garden’ in the usual sense, it’s definitely from a hemp farm.”²⁴

¹⁹ April 4, 2020 Office Action at TSDR 39 (emphasis in original).

²⁰ September 4, 2019 Office Action at TSDR 13-14.

²¹ *Id.*

²² *Id.* at 15-19.

²³ *Id.* at 19.

²⁴ April 4, 2020 Office Action at TSDR 7-8.

- Cali’s Best CBD (calisbestcbd.com) advertises pain relief medicine, where each pain capsule contains “25 mg of CBD, Extracted from Organic California Hemp.”²⁵ This source is located in San Francisco, California.²⁶
- Cali Botanicals (calibotanicals.com) advertises CBD tinctures that can be bought online and at its brick and mortar store located in Cordova, California.²⁷
- Cali Choice (calichoicedbd.com) advertises hemp-based products and is located in Long Beach, California.²⁸

It is well-settled that a geographic nickname, such as “Big Apple” or “Motown”, is treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public. *See In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007) (finding “Yosemite” – a well-recognized and frequently used shorthand reference to Yosemite National Park and the Yosemite region in general – conveys a readily recognizable geographic significance); *Carolina Apparel*, 48 USPQ2d at 1543. We find that the above evidence shows that the term CALI is a well-known nickname for the state of California and that it will be perceived as such by the purchasing public.

²⁵ *Id.* at 16.

²⁶ *Id.*

²⁷ *Id.* at 17-18.

²⁸ *Id.* at 19- 28.

The Examining Attorney also made of record several third-party registrations for marks incorporating the term CALI for use with goods similar to those identified in the involved application:

- CALI BARE for body lotions and creams registered on the Principal Register with a disclaimer of CALI (Reg. No. 5241912);²⁹
- CALI WHITE for, among other things, teeth whitening preparations, registered on the Supplemental Register (Reg. No. 5308617);³⁰
- THE CALI CONTOUR for cosmetics registered on the Principal Register with a disclaimer of CALI (Reg. No. 5504754);³¹
- CALI CHIC for various cosmetics registered on the Principal Register with a disclaimer of CALI (Reg. No. 5864106);³² and
- CALI INFUSION and Design for cosmetics registered on the Principal Register with a disclaimer of CALI INFUSION (Reg. No. 6008976).³³

These third-party registrations featuring goods that are the same as or similar to those of Applicant's are probative evidence on the issue of geographic descriptiveness as each mark is either registered on the Principal Register with a disclaimer of the term CALI or registered on the Supplemental Register. *See In re Morinaga Nyugyo K. K.*, 120 USPQ2d 1738, 1745 (TTAB 2016).

²⁹ *Id.* at 40-42.

³⁰ *Id.* at 43-45.

³¹ *Id.* at 46-47.

³² *Id.* at 48-50.

³³ *Id.* at 51-53.

Additionally, the Examining Attorney made of record certain census data that shows the state of California is the most populous state in the United States.³⁴ This is evidence that the location, i.e., California, is generally known. *Newbridge Cutlery*, 113 USPQ2d at 1449 (“Regarding the first prong of the test, that the population of the location is sizable ... is evidence that a location is generally known.”).

Applicant does not dispute that CALI is a nickname for the state of California or that California is the most populous state in the United States. Applicant argues, however, that the primary significance of the CALIHEMP mark is not geographic because other locations also have the name CALI.³⁵ To support its argument, Applicant points to evidence that Cali is the capital of the Valle del Cauca department and the most populous city in southwest Colombia.³⁶ Applicant argues that, as a result, there is insufficient evidence to establish that the term CALI will be perceived “solely” as signifying the state of California by the general public, particularly since the record does not show that the Colombian population in the United States is *de minimus*.³⁷

³⁴ April 4, 2020 Office Action at TSDR 54-58.

³⁵ Applicant’s brief (10 TTABVUE 7).

³⁶ *Id.*; September 4, 2019 Office Action at TSDR 12; March 3, 2020 Response to Office Action at TSDR 8-44.

Although Applicant refers to “Columbia” in its brief, we assume this is a typo and that it intends to reference the country “Colombia”, as this is consistent with the evidence of record. This issue was raised by the Examining Attorney in her brief (12 TTABVUE 8) but Applicant did not address it by, for example, filing a reply brief.

³⁷ Applicant’s brief (10 TTABVUE 7).

Applicant's argument is not persuasive. The fact that the term CALI may identify more than one geographic location does not detract from the term's primary geographic significance as a nickname for the state of California. *See, e.g., In re Cambridge Digital Sys.*, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design held primarily geographically descriptive of computer systems and parts thereof, where applicant's place of business is Cambridge, Massachusetts, even though there is more than one Cambridge). U.S. consumers will perceive CALI as referring to California given that CALI is well-known as the state's nickname and given Applicant's location in California as discussed in more detail below in connection with the second element. *Id.*

Applicant also argues that the primary significance of the mark is not a geographic location because the mark consists of two terms CALI and HEMP.³⁸ While Applicant acknowledges that the term HEMP is descriptive of a component of the goods identified in its involved application, Applicant argues that hemp is legal in more states than just California, and the Examining Attorney did not present sufficient evidence that the general population would identify hemp as being sourced "only from California."³⁹ Applicant concludes that "Due to the fact that hemp is legal outside of California, it is incumbent upon the Examining Attorney to present sufficient evidence to remove the other states where hemp is legal."⁴⁰

³⁸ Applicant's brief (10 TTABVUE 8).

³⁹ *Id.*

⁴⁰ *Id.* (10 TTABVUE 8-9).

Applicant's argument is not persuasive. As Applicant acknowledges, the term HEMP is merely descriptive because Applicant's identified goods include hemp as an ingredient. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) ("A mark is merely descriptive of goods within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient ... of the goods."). Therefore, we find that the inclusion of the term HEMP in the mark is not sufficient to establish a non-geographically descriptive significance for the mark CALIHEMP. That is, the addition of descriptive wording to a geographically descriptive term does not detract from the primary geographic significance of the mark. *See e.g., In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) ("The addition of a generic term to a geographic term does not avoid the refusal of primary geographic descriptiveness."); *Cambridge Digital*, 1 USPQ2d at 1662 ("[W]e do not believe that the addition of the highly descriptive word DIGITAL and the design detract from the primary geographic significance of the mark, CAMBRIDGE being the dominant origin-indicating feature of the mark."). This is true regardless of the fact that other states may have also legalized hemp-based products.

In sum, we find that the geographical significance of the term CALI in the CALIHEMP mark is its primary significance. Therefore, the first element has been met.

B. The Second Element – Origin of the Goods

Next, we consider whether Applicant's goods originate from the location, i.e., California. Applicant's address of record denotes that it is located in Watsonville,

California and Applicant acknowledges this in its brief.⁴¹ Further, Applicant stated during prosecution that its goods will be manufactured at Applicant's location in Watsonville, California⁴² and acknowledged the same in its brief.⁴³

Goods are considered to originate from a geographic location when the record shows that the applicant is located there or the goods are, for example, sold there, manufactured or produced there, or packaged and shipped from there. *See, e.g., In re Nantucket Allserve, Inc.*, 28 USPQ2d 1144 (TTAB 1993) (Product labeling clearly suggested to buyers that NANTUCKET NECTARS soft drinks were not only formulated on Nantucket Island (which they were, and corporate headquarters was also located there), but also manufactured there, whereas they were really manufactured in Worcester, Massachusetts.); *In re JT Tobacconists*, 59 USPQ2d 1080, 1083 (TTAB 2001) (holding applicant's cigars, cigar cases, and humidors originated from MINNESOTA because they were packaged and shipped from MINNESOTA, and applicant's business was located in MINNESOTA). Here, the record establishes that Applicant is located in California and that it intends to manufacture its goods there as well. Thus, we find that Applicant's goods originate in California.

Thus, the second element has been met.

⁴¹ Applicant's brief (10 TTABVUE 7).

⁴² March 3, 2020 Response to Office Action at TSDR 3.

⁴³ Applicant's brief (10 TTABVUE 3).

C. The Third Element – Goods/Place Association

Having found that the first two elements have been met, we now consider the goods/place association. When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, for purposes of Section 2(e)(2) of the Trademark Act, the goods/place association may ordinarily be presumed from the fact that Applicant's goods originate in or near the place named in the mark. *See e.g., In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, 1621 (TTAB 2007) (YOSEMITE BEER held geographically descriptive of beer produced and sold in a brewpub in Merced, California, the Board stating that “[s]ince the goods originate at or near [Yosemite National Park], we can presume an association of applicant's beer with the park.”); *JT Tobacconists*, 59 USPQ2d at 1082 (“[W]here there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named by the term is neither obscure nor remote, a public association of the goods or services with the place may ordinarily be presumed from the fact that the applicant's goods or services come from the geographical place named in the mark.”). Accordingly, having found that the first two elements are met, we may presume that the third element is also met.

Applicant argues that none of the proffered evidence would cause the average American consumer, including the Colombian population in the United States, to make a goods/place association.⁴⁴ We disagree. Applicant has merely presented evidence that the term CALI could signify a city in Colombia and nothing more; as

⁴⁴ Applicant's brief (10 TTABVUE 7).

such, its arguments do not overcome the evidence of record that the primary significance of the term CALI to US consumers would be California. Applicant's arguments also ignore the fact that Applicant itself is located in California and intends to produce its goods there; and (2) that the above evidence of third-party websites, such as Cali Cannabis Marketplace, Cali CBD, Cali Garden CBD and others, show a reasonable basis for concluding that the public is likely to believe that the CALI portion of the mark identifies the place, i.e., California, from which the goods will originate. Consequently, Applicant has failed to rebut the presumption that arises from having found that the first two elements of the test for geographical descriptiveness have been met.

In sum, we find that the third element is met.

D. Conclusion

We find the primary significance of the term CALI in Applicant's CALIHEMP mark to be the state of California, a geographical location that is generally known to the relevant United States consumer. Because Applicant is located in California and acknowledges that its goods will originate from there, we presume that the relevant consumers will make a goods/place association. In view thereof, we find CALIHEMP to be primarily geographically descriptive of the goods in the involved application under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2).

III. Decision

The refusal to register Applicant's mark under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), is affirmed.